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**FACSIMILE  
TRANSMISSION  
TO USPTO**

|   |                                |
|---|--------------------------------|
| CERTIFICATION OF FACSIMILE TRANSMISSION.  |                                |
| I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FACSIMILE<br>TRANSMITTED TO THE USPTO ON THE DATE SHOWN BELOW. |                                |
| Date of Transmission:   | November 19, 2004              |
| Name of Person Making Transmission:   | Terri McDonald                 |
| Signature:  | <i>Terri McDonald</i> 11/19/04 |

DOCUMENT(S) FAXED:

PAGES ATTACHED: 19

|              |                      |
|--------------|----------------------|
| Re Applic of | David J. Hathaway    |
| Docket No.   | FIS920010383US1      |
| Serial No.   | 10/078,876           |
| Filing Date  | 2/20/02              |
| Attorney     | H. Daniel Schnurmann |

Attached: RESPONSE TO NOTICE OF NON-COMPLIANT AMENDMENT  
AMENDMENT DATED 9/27/04

PLEASE DELIVER TO:  
EXAMINER: JOSEPH D. TORRES  
ART UNIT: 2133  
PHONE NO:  
FAX NO: 703-872-9306

THIS MESSAGE IS INTENDED ONLY FOR THE USE OF THE INDIVIDUAL OR ENTITY TO WHICH IT IS ADDRESSED, AND MAY CONTAIN INFORMATION THAT IS PRIVILEGED, CONFIDENTIAL AND EXEMPT FROM DISCLOSURE UNDER APPLICABLE LAW. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT, OR THE EMPLOYEE OR AGENT RESPONSIBLE FOR DELIVERING THE MESSAGE TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION OR COPYING OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE TO US AT THE ADDRESS TO THE RIGHT VIA THE U.S. POSTAL SERVICE.

INTERNATIONAL BUSINESS MACHINES CORPORATION

Intellectual Property Law  
East Fishkill Facility  
2070 Route 52  
Hopewell Junction  
New York 12533-6531

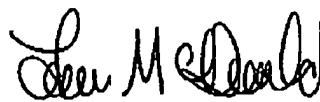
Fax: 845-892-6363  
Phone: 845-894-2580

## Date of Transmission:

I hereby certify that this paper and fee are being transmitted via facsimile on November 19, 2004 to the Commissioner for Patents in accordance with 37 CFR Sec. 1.6(d) on the date indicated above.

Teri McDonald

Name of Person Transmitting Paper and Fee


 11/19/04  
 Signature of Person Transmitting Paper and Fee

| IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  |   |
|---|---|
| In re application of: David J. Hathaway, et al.   | Date: November 19, 2004   |
| Serial Number: 10/078,876   | Examiner: Joseph D. Torres  |
| Filed: 2/20/02  | Group Art Unit: 2133  |
| Title: Method for Reducing Switching Activity During a Scan Operation with Limited Impact on the Test Coverage of an Integrated Circuit | IBM Corporation<br>D/18G, B/300, Zip 482<br>2070 Route 52<br>Hopewell Junction, NY 12533-6531 |

**RECEIVED**  
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NOV 19 2004

 Commissioner of Patents and Trademarks  
 Alexandria, VA 22313

Sir:

Responsive to the Notice of Non Compliant Amendment dated November 8, 2004, we are resubmitting the Amendment filed on September 27, 2004 including the page containing claims 6-8 that are deemed to be missing.

Please debit our deposit account 09-0458 the fee corresponding to one month extension which is believed to be due.

 Respectfully submitted,  
 David J. Hathaway, et al.

By:

  
 H. Daniel Schnurmann  
 Registration No. 35,791  
 Telephone: (845) 894-2481

10/078,876

1

FIS920010383US1

## Auto-Reply Facsimile Transmission



TO: Fax Sender at 845 892 6363  
Fax Information  
Date Received: 9/27/2004 3:12:39 PM [Eastern Daylight Time]  
Total Pages: 14 (including cover page)

**ADVISORY:** This is an automatically generated return receipt confirmation of the facsimile transmission received by the Office. Please check to make sure that the number of pages listed as received in Total Pages above matches what was intended to be sent. Applicants are advised to retain this receipt in the unlikely event that proof of this facsimile transmission is necessary. Applicants are also advised to use the certificate of facsimile transmission procedures set forth in 37 CFR 1.8(a) and (b), 37 CFR 1.6(f). Trademark Applicants, also see the Trademark Manual of Examining Procedure (TMEP) section 306 et seq.

Received  
Cover  
Page

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|   |  |   |  |            |                 |            |            |             |         |          |                     |
|---|--|---|--|------------|-----------------|------------|------------|-------------|---------|----------|---------------------|
| SEP 27 '04 13:35 PR IPIAW E FISHKILL 845 892 6363 TO 917038729306 P.01/14   |  |   |  |            |                 |            |            |             |         |          |                     |
| <b>FACSIMILE<br/>TRANSMISSION<br/>TO USPTO</b>  |  |   |  |            |                 |            |            |             |         |          |                     |
| <small>CERTIFICATION OF FACSIMILE TRANSMISSION<br/>I HEREBY CERTIFY THAT THIS COMMUNICATION IS BEING MADE<br/>DIRECTLY TO THE USPTO OR THE USPTO'S AGENT.<br/>Date of Transmision: September 27, 2004<br/>Name of Person Making Transmission: TEL INFORMATION<br/>Signature: <i>[Signature]</i> 9/27/04</small>   |  |   |  |            |                 |            |            |             |         |          |                     |
| DOCUMENT(S) FACSIMILED:   | PAGES ATTACHED: 14   |   |  |            |                 |            |            |             |         |          |                     |
| <table border="1"><tr><td>Re Appl. of</td><td>David J. Hathaway, et al.</td></tr><tr><td>Docket No.</td><td>FIG920010383U61</td></tr><tr><td>Serial No.</td><td>10/078,876</td></tr><tr><td>Filing Date</td><td>2/20/02</td></tr><tr><td>Attorney</td><td>M. Daniel Schnurman</td></tr></table>   |  | Re Appl. of   | David J. Hathaway, et al.  | Docket No. | FIG920010383U61 | Serial No. | 10/078,876 | Filing Date | 2/20/02 | Attorney | M. Daniel Schnurman |
| Re Appl. of   | David J. Hathaway, et al.  |   |  |            |                 |            |            |             |         |          |                     |
| Docket No.  | FIG920010383U61  |   |  |            |                 |            |            |             |         |          |                     |
| Serial No.  | 10/078,876   |   |  |            |                 |            |            |             |         |          |                     |
| Filing Date   | 2/20/02  |   |  |            |                 |            |            |             |         |          |                     |
| Attorney  | M. Daniel Schnurman  |   |  |            |                 |            |            |             |         |          |                     |
| Attached: AMENDMENT TRANSMISSION SHEET<br>AMENDMENT   |  |   |  |            |                 |            |            |             |         |          |                     |
| <table border="1"><tr><td>PLEASE DELIVER TO:<br/>EXAMINER: Joseph D. Yentes<br/>ART UNIT: 2113<br/>PHONE NO:<br/>FAX NO: 703-672-9306</td><td>INTELLIGENT BUSINESS MACHINES CORPORATION<br/>Intelligent Property Law<br/>East Franklin Facility<br/>3070 Route 63<br/>Westerville, Ohio 43081<br/>Phone: 614-873-4221<br/>Fax: 614-873-4363<br/>Phone: 614-874-2560</td></tr></table> |  | PLEASE DELIVER TO:<br>EXAMINER: Joseph D. Yentes<br>ART UNIT: 2113<br>PHONE NO:<br>FAX NO: 703-672-9306 | INTELLIGENT BUSINESS MACHINES CORPORATION<br>Intelligent Property Law<br>East Franklin Facility<br>3070 Route 63<br>Westerville, Ohio 43081<br>Phone: 614-873-4221<br>Fax: 614-873-4363<br>Phone: 614-874-2560 |            |                 |            |            |             |         |          |                     |
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| PAGE 1/14 RCV'D AT 9/27/2004 3:12:39 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/4 * DNIS:8729306 * CSID:845 892 6363 * DURATION (mm:ss):05:34   |  |   |  |            |                 |            |            |             |         |          |                     |

\*\* TX STATUS REPORT \*\*

AS OF SEP 27 '04 10:38 PAGE.01

[REDACTED]  
IPLAW E FISHKILL

|       |       |              |      |         |     |      |        |
|-------|-------|--------------|------|---------|-----|------|--------|
| DATE  | TIME  | TO/FROM      | MODE | MIN/SEC | PGS | CMD# | STATUS |
| 09/27 | 16:35 | 917038729306 | EC-S | 03'30"  | 014 | 159  | OK     |

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TRANSMISSION  
TO USPTO**

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I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FACSIMILE  
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Date of Transmission: September 27, 2004  
Name of Person Making Transmission: Teri McDonald  
Signature: *[Signature]* 9/27/04

DOCUMENT(S) FAXED:

PAGES ATTACHED: 14

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| Re Applic of | David J. Hathaway, et al. |
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| Filing Date  | 2/20/02                   |
| Attorney     | H. Daniel Schnuzmann      |

Attached: AMENDMENT TRANSMITTAL SHEET  
AMENDMENT

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FAX NO: 703-872-9306

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New York 12533-6531

Fax: 845-892-6363  
Phone: 845-894-2580

**AMENDMENT TRANSMITTAL LETTER (Large Entity)**

Applicant(s): David J. Hathaway, et al.

Docket No.

PIS9200103830S1

|                               |                        |                              |                       |                        |                          |
|-------------------------------|------------------------|------------------------------|-----------------------|------------------------|--------------------------|
| Application No.<br>10/078,876 | Filing Date<br>2/20/02 | Examiner<br>Joseph D. Torres | Customer No.<br>32074 | Group Art Unit<br>2133 | Confirmation No.<br>6368 |
|-------------------------------|------------------------|------------------------------|-----------------------|------------------------|--------------------------|

Invention: Method for Reducing Switching Activity During a Scan Operation with Limited Impact on the Test Coverage of an Integrated Circuit

**COMMISSIONER FOR PATENTS:**

Transmitted herewith is an amendment in the above-identified application.

The fee has been calculated and is transmitted as shown below.

**CLAIMS AS AMENDED**

|  | CLAIMS REMAINING<br>AFTER AMENDMENT | HIGHEST #<br>PREV. PAID FOR | NUMBER EXTRA<br>CLAIMS PRESENT | RATE      | ADDITIONAL<br>FEE |
|--|-------------------------------------|-----------------------------|--------------------------------|-----------|-------------------|
| TOTAL CLAIMS   | 23                                  | 23 =                        | 0                              | x \$18.00 | \$0.00            |
| INDEP. CLAIMS  | 3                                   | 3 =                         | 0                              | x \$86.00 | \$0.00            |
| Multiple Dependent Claims (check if applicable) <input type="checkbox"/> |                                     |                             |                                |           | \$0.00            |
| <b>TOTAL ADDITIONAL FEE FOR THIS AMENDMENT</b>                           |                                     |                             |                                |           | <b>\$0.00</b>     |

- No additional fee is required for amendment.
- Please charge Deposit Account No. \_\_\_\_\_ in the amount of \_\_\_\_\_
- A check in the amount of \_\_\_\_\_ to cover the filing fee is enclosed.
- The Director is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 09-0458
  - Any additional filing fees required under 37 C.F.R. 1.16.
  - Any patent application processing fees under 37 CFR 1.17.



Signature

H. Daniel Schurmann  
Agent  
Registration No.: 35,791

Dated: September 27, 2004

I certify that this document and fee is being sent via facsimile on September 27, 2004 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Signature of Person Mailing Correspondence

Teri McDonald

Typed or Printed Name of Person Mailing Correspondence

cc: